

**REMARKS**

The Applicants respectfully request reconsideration of the present Application in view of the foregoing amendments and in view of the reasons that follow.

**Status**

Claims 4, 5, and 7-15 were pending. Claims 1-3 have been withdrawn by the Examiner following a restriction requirement.

Claims 4 and 5 are currently being amended. (Withdrawn Claim 1 is also being amended.)

Claims 15-18 are being added.

After amending the claims as set forth above, Claims 4, 5, and 7-18 are now pending in this Application.

The Applicants believe that the present Application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

**Substance of the (Telephonic) Interview**

On November 17, 2008, the Examiner and the undersigned representative of the Applicants conducted a telephone interview. The Applicants thank the Examiner for the opportunity to discuss Claim 4, potential amendments to Claim 4, and the cited prior art, and for the Interview Summary dated November 26, 2008.

The undersigned representative of the Applicants and the Examiner disagreed about the meaning of “removable.” The Examiner asserted that something is “removable” even if it or its environment were broken in the process. The undersigned representative for the Applicants referenced cases cited in the prior response and stated that the definition would not be met if something had to be broken to be removed. The Examiner stated that such a construction would need to be appealed.

**Claim Rejections – 35 U.S.C. § 112 ¶ 2**

On page 2 of the Office Action, the Examiner rejected Claims 4, 5, and 7-14 under 35 U.S.C. § 112 ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regard as the invention. The Examiner stated:

Applicant recites at Claim 4 that the buffer reservoir is removable from and “replaceable in . . . as a separate unit”. [1] It is not clear if the reservoir is replaced with a different element or if the claimed reservoir is placed back into the apparatus. [2] It is not clear from the claim how this process is done. There is recited no means for performing the claimed function or supporting or releasing the reservoir.

The Applications respectfully disagree with this rejection and believe that this rejection is moot in view of the amendment to independent Claim 4.

Regarding the first issue identified by the Examiner, the Applicants submit that the scope of the claim and its status in view of the cited prior art does not depend on whether the same or a different buffer reservoir is replaced in the apparatus in the claims presented and as amended. The Application indicates that “the first buffer reservoir can be formed by an opened, disposable cup filled with a creamer, or by a refillable holder” (see, e.g., paragraphs [0010] and [0035] of the published Application). The Applicants submit that it can be either the same first buffer reservoir or a different first buffer reservoir.

Regarding the second issue identified by the Examiner, Claim 4 as amended clarifies how the removal/replacement is done – the first buffer reservoir is positioned at least partially in the second buffer reservoir without being permanently attached. An exemplary embodiment in the Application shows/describes the first buffer reservoir being inserted into the open top of the second buffer reservoir such that the bottom rests on the bottom 22 of the second buffer reservoir (see, e.g., Figure 1f and paragraphs [0028] and [0040] of the published application).

The Applicants request withdrawal of the rejection of Claims 4, 5, and 7-14 under 35 U.S.C. § 112 ¶ 2.

**Claim Rejections – 35 U.S.C. § 102**

On pages 2-3 of the Office Action, the Examiner rejected Claims 4, 5, and 7-14 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,009,792 (“Kraan”).

The Examiner stated that:

There is disclosed in Kraan a beverage preparation apparatus, comprising: a holder 4 for supporting a coffee cartridge, the holder having an inlet 24 and outlet 20, the outlet forming a nozzle 22; a hot water means 38, 40, 42 for supplying hot water under pressure; a first buffer reservoir 28 having a first outflow path 30; a second buffer reservoir 25 having a second outflow path 26, the second buffer reservoir forming an impact surface (bottom of housing 32) positioned relative to the first buffer reservoir; wherein, if desired, the first buffer reservoir can be removed from the second reservoir.

In regards to the first buffer reservoir being removable, it is apparent that the buffer reservoir of Kraan could be removed by some means if so desired and again placed within the apparatus.

In regards to the presence of creamer within the first buffer reservoir, such is a desired used provides no structural limitations to the claims.

Claim 4 is in independent form and recites an “apparatus for the preparation of a cappuccino from a coffee extract and an instant and/or liquid creamer” comprising, in combination with other elements, a “second buffer reservoir having a bottom and upstanding sidewalls” “wherein the first buffer reservoir is positioned at least partially in the second buffer reservoir” and “wherein the first buffer reservoir is not permanently connected to the second buffer reservoir and is readily removable from, and replaceable in, the second buffer reservoir as a separate unit.” Claims 5 and 7-14 depend from independent Claim 4.

Kraan is directed to an apparatus 1 for preparing coffee. The apparatus 1 includes a housing 2 and a cup-shaped holder 4. The holder is detachably placed on the housing 2 and is configured to receive a pouch 6 of ground coffee (for example). The housing also includes a liquid receiving space 25 (which the Examiner asserts to be the “second buffer reservoir” as

recited in the pending Application). A cup-shaped collecting reservoir 28 is located in the liquid receiving space 25 (the Examiner asserts that this collecting reservoir 28 is the “first buffer reservoir” as recited in the pending Application). During operation, hot water passes through pouch 6 and collects as coffee extract in the recess. The coffee extract then sprouts through a sprout opening 22 into the collecting reservoir 28. As the coffee sprouts into the surface of the liquid filling the collecting reservoir 28, a café crème is formed.

Kraan does not identically disclose an “apparatus” comprising, among other elements, a “second buffer reservoir having a bottom and upstanding sidewalls” “wherein the first buffer reservoir is positioned at least partially in the second buffer reservoir” and “wherein the first buffer reservoir is not permanently connected to the second buffer reservoir and is readily removable from, and replaceable in, the second buffer reservoir as a separate unit” as recited in independent Claim 1

In Kraan, the holder 4 is removable, not the collecting reservoir 28. To remove the reservoir 28 in Kraan would require damage and destruction of the collecting reservoir 28 and the cup shaped element 32. Courts have interpreted this or similar terms/phrases, in reported and non-reported cases. See, for comparison, V-Formation, Inc. v. Benetton Group SpA, 401 F3d 1307, 1311-12 (“releasably attaching” construed to “mean that fasteners ‘must permit the sidewalls to be easily removed and replaced’ and determining that ‘those skilled in the art would not consider rivets . . . to fall within the category of releasable fasteners.’”); K-2 Corp. v. Salomon S.A., 191 F.3d 1356, 1363-65 (“Screws, unlike rivets and laminates, are meant to be unscrewed, that is, to be removed. A rivet or a laminate, to the contrary, is meant to remain permanent, unremoveable unless one is bent on breaking the permanent structure apart.”); Fargo Electronics, Inc. v. Iris Ltd., Inc., (not reported in F.Supp.2d) 2005 WL 3241851, at \*13 (D. Minn. Nov. 30, 2005) (“removable” is “capable of being taken away from a position without damaging the surrounding structure”); Fargo Electronics, Inc. v. Iris, Ltd., Inc., (not reported in F.Supp.2d) Slip Copy, 2006 WL 3839931 (D. Minn. December 29, 2006) (Court characterizing its construction of “removable” as the opposite of “permanently secured”). Accordingly,

“removable” does not encompass breaking the structure apart. The rejection of Claim 4 (as amended) over Kraan is not proper. Claim 4 is patentable over Kraan.

Dependent Claims 5 and 7-14, which depend from independent Claim 1, are also patentable. See 35 U.S.C. § 112 ¶ 4.

The Applicants respectfully request withdrawal of the rejection of Claims 4, 5, and 7-14 under 35 U.S.C. § 102(b)

### **Amendment of Withdrawn Claims**

Claims 1-3 had been withdrawn by the Examiner after a restriction requirement. Withdrawn Claim 1 has been amended to be commensurate in scope with the product claims so that the withdrawn process claims may be considered for rejoinder upon allowance of the product claims. See M.P.E.P. § 806.05.

### **New Claims**

Claims 15-18 have been added. Support for these new claims may be found, for example, in Figures 1e, 1f, 3a, and paragraphs [0027], [0028], [0031]. No new matter has been added. Also, the “without being connected to” in Claim 15 and the “angled bottom” element in Claim 16 are based on suggestions by the Examiner during the telephone interview on November 17, 2008.

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Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to

Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date December 12, 2008

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